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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,918	01/31/2001	Hideyuki Amaku	826.1671/JDH	9990

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EXAMINER
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NGUYEN, MERILYN P

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/772,918

Applicant(s)

AMAKU ET AL.

Examiner

Merilyn P. Nguyen

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Detailed Action.

### **DETAILED ACTION**

1. This application claims foreign priority Application No. 2000-181687 filed on June 16, 2000.

2. In response to the communication dated 03/23/2005, claims 1-15 are active in this application.

### ***Acknowledges***

3. Receipt is acknowledged of the following items from the Applicant:
- o The applicant's amendments received March 23, 2005 have been considered and made of record.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 4 and 7-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment to the claims has introduced new terms: "undistributed" and

Art Unit: 2161

“undistributively” at claim 1, lines 5 and 7, claim 4, lines 2 and 4, claim 7, lines 2 and 4, claim 8, lines 5 and 7, claim 9, lines 5 and 7, claim 10, lines 2 and 4, claim 11, lines 2 and 4, claim 12, lines 5 and 7, claim 13, lines 4 and 6, claim 14, lines 4 and 5, and claim 15, lines 4 and 7.

Nowhere in the original specification describes or supports “an undistributed shared storage medium” instead of “a shared storage medium”. In the interest of compact prosecution, since there is nowhere in the specification introduce or describe “undistributed” storage, thus has no patentable weight.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 4 and 7-15 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claims 1-15 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in the reply filed 03/23/2005. In that paper, applicant has stated “the data for the systems 15-19 is not distributed among the systems 15-19 but held in storage 44 and, thus, is not distributed or is “undistributed” data” (page 7, paragraph 2 of the Remarks), and this statement indicates that the invention is different from what is defined in the claim(s) because the claims recite “an undistributed shared storage medium” which meant to the Examiner as this storage medium is not distributed not the data.

7. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 2161

Regarding claims 1-7 and 14-15 are being incomplete for omitting structural cooperative relationships between devices and systems. See MPEP § 2172.01.

Regarding claim 1, line 4, claim 2, line 4, claim 8, line 3, claim 9, line 4, and claim 12, line 3, there is insufficient antecedent basis for “a process”. For example, it’s unclear whether “a process” at line 4 is the same with “a process” at line 2.

Regarding claim 2, lines 9 and 12, claim 4, line 8, claim 5, lines 8-9 and 17, claim 7, lines 7-8, claim 10, line 8, claim 11, line 8, and claim 14, line 9, there is insufficient antecedent basis for “the storage system” or “said storage system”.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 4, and 7-13 stand rejected under 35 U.S.C. 102(b) as being anticipated by Nakagaki (US 5,857,077).

Regarding claims 1, 8, 9, 12, and 13, Nakagaki discloses a recording system, a recording method, a computer-readable storage medium, and a propagating signal, comprising:

- a generation device generating process information for indicating a content of a process in a specific system (See col. 9, line 66 to col. 10, line 16); and
- a recording device performing a process for recording the process information of the specific system in an undistributed shared storage medium (see col. 10, lines

17-46) that is shared by a plurality of systems including the specific system and is commonly accessed by the plurality of systems (See Fig. 1, 7, and 9, as illustrated as two way arrows interchanging information with other information systems) and that collectively and undistributively stores a plurality of pieces of process information of the plurality of systems (See col. 10, lines 41-46), in a format such that a process history of the plurality of systems can be tracked (See col. 10, lines 47- 65).

Regarding claims 4 and 10, Nakagaki discloses a retrieval system, comprising:

- a retrieval device (History collection section 16, Fig. 1) performing a process for retrieving data from an undistributed shared storage medium (Collected history holding section 17, Fig. 1) that is shared by a plurality of systems and is commonly accessed by the plurality of systems (See Fig. 1, 7, and 9, as illustrated as two way arrows interchanging information with other information systems) and that undistributively and collectively stores process information for indicating a content of each process of the plurality of systems (See col. 10, lines 41-46), in a format such that a process history of the plurality of systems can be tracked (See col. 10, lines 47- 65); and
- a generation device generating the process history from the information obtained from the storage medium by retrieval (See col. 62, lines 47-56).

Regarding claims 7 and 11, Nakagaki discloses a retrieval system, comprising:

Art Unit: 2161

- a retrieval device (History collection section 16, Fig. 1) performing a process for retrieving data from an undistributed shared storage medium (Collected history holding section 17, Fig. 1) that is shared by a plurality of systems and is commonly accessed by the plurality of systems (See Fig. 1, 7, and 9, as illustrated as two way arrows interchanging information with other information systems) and that undistributively and collectively stores process information for indicating a content of each process of the plurality of systems (See col. 10, lines 41-46), in a format such that a process history of the plurality of systems can be tracked (See col. 10, lines 47- 65); and
- a process device processing information using the information obtained from the storage medium by retrieval (See col. 61, line 40 to col. 62, line 33).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakagaki (US 5,857,077), in view of Oku (US 6,098,047).

Art Unit: 2161

Regarding claim 14, Nakagaki discloses an electronic data interchange system (Figs. 1, 7, for example), comprising:

- o first and second systems (Systems A and B, Fig. 7) exchanging transactions where each transaction has a transaction process history (Col. 9, line 66 to Col. 10, line 16); and
- o a undistributed shared, commonly accessed, collective storage system collectively and undistributively storing the transaction process history of each transaction (Collected history holding section 17, Fig. 1), allowing access to the transaction process history of each transaction by said first and second systems (See Figs. 1 and 7, as illustrated as two way arrows interchanging information with other information systems), and wherein the first and second systems track the transactions using the transaction process history of each transaction stored in said storage system (See col. 11, line 63 to col. 12, line 21, See also col. 61, line 40 to col. 62, line 33).

Nakagaki does not teach transactions are business transactions. On the other hand, Oku teaches exchanging business transactions between systems of different organizations (See col. 3, lines 18-37, Oku et al.). It would have been obvious to one having ordinary skill in the art to exchange business transactions as suggested by Oku. Since Nakagaki system exchanging various pieces of information between systems (Col. 1, lines 23-27, Nakagaki et al.), it was well known that business transactions information could also be exchanged so that the system can flexibly apply to all types of information. This is regarded as intended and, thus, not given patent able weight. A claim containing a "recitation with respect to the manner in which a



Art Unit: 2161

claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

Regarding claim 15, this claim contains the same limitation of claim 14, thus is rejected as addressed above in claim 14.

### ***Response to Remarks/Arguments***

10. Applicant's remarks/arguments filed on 03/23/2005 about the claim rejection of the last Office Action have been fully considered, but they are not persuasive.

Claims 1, 4, and 7-15 do not meet the requirement under 35 U.S.C. 112, first paragraph as addressed above. The applicant amends the claims to overcome the prior art of record. However, the amended claims lack enablement. Therefore, the examiner, respectfully considers it as non patentable subject matter under 35 USC 112, first paragraph. Thus, the rejections stand as set forth above. Also, the examiner submits that **even if** the terms of the claims may appear to be definite, inconsistency with the specification disclosure or prior art teachings may make an otherwise definite claim take on an unreasonable degree of uncertainty. The examiner respectfully points out that the applicant fails to represent the disclosure in the argument in order to support the claim language. The newly added term of “undistributed/undistributively” is not supported by the applicant disclosure. The applicant is directed to page 15, lines 1-3, of the specification, where “storage medium” is distributed among a plurality of systems. Thus, it’s not “undistributed” storage medium. In re Cohn, 438 F.2d 989, 169 USPQ 95 (CCPA 1971); In re Hammack, 427 F.2d 1378, 166 USPQ 204 (CCPA 1970). In Cohn, the claim was directed to a

Art Unit: 2161

process of treating a surface with a corroding solution until the metallic appearance is supplanted by an “opaque” appearance. Noting that no claim may be read apart from and independent of the supporting disclosure on which it is based, the court found that the description, definitions and examples set forth in the specification relating to the appearance of the surface after treatment were inherently inconsistent and rendered the claim indefinite.

Applicant has stated “the data for the systems 15-19 is not distributed among the systems 15-19 but held in storage 44 and, thus, is not distributed or is “undistributed” data” (page 7, paragraph 2 of the Remarks), and this statement indicates that the invention is different from what is defined in the claim(s) because the claims recite “an undistributed shared storage medium” which meant to the Examiner as this storage medium is undistributed not the data.

The Examiner points out that the recitation of “an undistributed shared storage medium” is broadly read by Nakagaki such that each of the systems A, B, C, D, E has it’s own undistributed shared storage medium.

#### ***Allowable subject matter***

11. Claims 2 and 5 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action. The reasons for allowance are stated in the previous Office Action mailed January 30, 2004.

#### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2161

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Merilyn P Nguyen whose telephone number is 571-272-4026. The examiner can normally be reached on M-F: 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

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June 08, 2005

  
**FRANTZ COBY**  
**PRIMARY EXAMINER**